

REMARKS

Claims 1-29 remain pending in the current application. Claims 1, 5-8, 16, 17, and 23- 25 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,212,555 to Brooks, Jr. et al. (hereinafter "Brooks"), claims 3, 18, 19, 26, and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brooks, and claims 2, 4, 28, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brooks in view of U.S. Patent No. 6,147,938 to Ogawa et al (hereinafter "Ogawa").

Allowable Subject Matter

Claims 9-15 are allowed. Also, claims 20-22 would be allowed if rewritten to overcome the 35 U.S.C. § 112, second paragraph rejection and rewritten in independent form. Applicant respectfully requests that the Examiner hold in abeyance the rewriting in independent form until the Examiner has had an opportunity to reconsider (and withdraw) the prior art rejection of the other claims.

35 U.S.C. §112, second paragraph:

1. *Claims 16-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant submits that the amendments overcome the rejection.*

Rejections under 35 U.S.C. §102

2. *Claims 1, 5-8, 16, 17, and 23-25 stand rejected under 35 U.S.C. §102(e) as being anticipated by Brooks. This rejection is respectfully traversed.*

Claim 1 recites a corresponding information generating device which generates correspondence information corresponding to each of the plurality of unit information and, indicating a content of each of the plurality of unit information. Also, claim 1 comprises a transmitting device which transmits the corresponding information to the transferring device, and an obtaining device which obtains only reproduction control information generated by the generating apparatus on the basis of the transmitted correspondence information.

The Examiner maintains that Brooks discloses a transmission means 5 that corresponds to the claimed transmitting device, but Applicants disagree. For example, the transmission means 5 transfers digital audio data from a computer server 1 to an audio receiver/player device 6. Col. 3, lines 30-45. However, Brooks does not disclose, teach, or suggest that the transmission means 5 transmits corresponding information, which 1) corresponds to each of a plurality of unit information of stored audio information, 2) indicates a content of each of the plurality of unit information, and 3) is generated by a corresponding information generating device.

Thus Brooks cannot anticipate the claimed invention in claim 1.

Claims 5 and 6 should be patentable at least by virtue of their dependency from claim 1.

Applicant submits that the rejection to independent claims 7 and 16 should be withdrawn for reasons similar to those discussed above with respect to independent claim 1.

Claims 8, 17, and 23-25 are patentable at least by virtue of their dependency from claim 7 or 16.

Rejections under §103

3. *Claims 3, 18-19, 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brooks. Applicant respectfully traverses the rejection.*

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP §2142. Section 2142 further states that “[t]he initial burden is on the examiner to provide some suggestion of desirability of doing what the inventor has done.”

As discussed above, Brooks does not teach all aspects of the claimed invention found in claims 1 and 16 and therefore claims 3, 18, 19, 26 and 27 are patentable over the prior art at least by virtue of their dependency.

In the Final Office Action dated April 5, 2005, the Examiner objected claim 19 was as being dependent upon a rejected base claim, but indicated that it would be patentable if rewritten in independent form. Despite not being substantially amended in the Amendment on April 5, 2005, claim 19 was subsequently rejected in the present Office Action dated June 16, 2005.

As previously noted, claim 19 should be patentable at least by virtue of its dependency from claim 16. Additionally, claim 19 is patentable over the prior art, because there is no motivation to modify the reference as suggested by the Examiner. The Examiner concedes that Brooks fails to disclose the particular order of how the audio data is reproduced. However, the Examiner then argues that the claim limitation is a well-known sorting technique, and it would thus be obvious to one of ordinary skill in the art to modify Brooks as to include such a technique. However, when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. In re Kotzab,

55 USPQ2d at 1316-1317 (citing *B.F. Goodrich Co. v. Aircraft Breaking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996)); see also MPEP § 2142 (quoting *Ex parte Clapp*, 227 USPQ 972, 973 (B. Pat. App. & Inter. 1985)) (“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.”). The Examiner provides no specificity as to why this modification would have been obvious, nor does the Examiner make particular findings stating why the modification would have been obvious. That a “sorting technique” may have been “well known” is not sufficient motivation for modifying Brooks to include reproducing two songs in an order different from that in which they were stored, as set forth in claim 19. Thus, claim 19 should be patentable over Brooks.

4. *Claims 2, 4, 28 and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brooks in view of Ogawa et al. (U.S. 6,147,938).* Applicant respectfully traverses the rejection. Since claims 2, 4, 28 and 29 are dependent upon claim 1 or 16, and since Ogawa does not cure the deficient teachings of Brooks with respect to claims 1 and 16, claims 2, 4, 28 and 29 are patentable at least by virtue of their dependency.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No. 09/725,809

Attorney Docket No. Q62005

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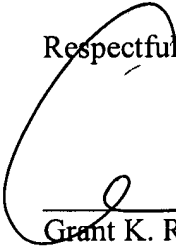
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